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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/302,336 04/29/99 AVERILL

R 54839USA3A

EXAMINER

TM02/0425

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ART UNIT

PAPER NUMBER

2166

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/302,336

Applicant(s)

AVERILL ET AL.

Examiner

Sam Rimell

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

SAM RIMELL
PLUMMER EXAMINER
AU 2166

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2166

In response to the restriction requirement, applicant has elected claims 1-12. In particular, applicant has traversed the combination/subcombination requirement, by arguing that multiple dependencies in the claims to the combination do not prove that the combination does not require the particulars of the of the subcombination. Examiner maintains that when multiple dependencies are used to claim the combination, it proves that the particulars of the subcombination are not critical to the combination. The restriction requirement is maintained and made final.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory

Claims 1-12 are addressed to a method of categorizing and subcategorizing standard medical codes used in describing medical care.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a useful, concrete and tangible result (*State Street Bank and Trust Co. V. Signature Financial Group, Inc.* 149 F.3d at 1373, 47 USPQ 2nd at 1601-02).

A process that consists solely of the manipulation of an abstract idea or abstract ideas is not concrete or tangible (*In re Warmerdam* 33 F.3d 1354, 1360, 31 USPQ 2nd 1754, 1759, (Fed. Cir. 1994).

Only when a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 USC 101 (MPEP 2106).

Art Unit: 2166

Claims 1-12 are non-statutory since they only involve the manipulation of categories of medical codes. The manipulation of these medical codes is not claimed as producing any concrete or tangible outcome, and thus do not meet the requirements of *In re Warmerdam* recited above for the establishment of a statutory invention.

In order to address this rejection, applicant may wish to further define a concrete or tangible outcome, such as "classification of a patient medical condition", "classifying costs associated with medical care" or "predicting future costs associated with medical care".

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2166